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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,034	02/19/2002	Jean-Guy Chouinard	14079-1US-RGH/ik	6419
20988	7590	04/04/2006	EXAMINER	
OGILVY RENAULT LLP 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL, QC H3A2Y3 CANADA			TIBBITS, PIA FLORENCE	
			ART UNIT	PAPER NUMBER
			2838	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/079,034

**Applicant(s)**

CHOUINARD ET AL.

**Examiner**

Pia F. Tibbits

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/19/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-18 is/are rejected.
- 7) ☒ Claim(s) 4-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/19/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office action is in answer to the reissue application and the preliminary amendment filed 2/19/2002.

#### ***Oath/Declaration***

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. US 6275006 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error, which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414 stating: "It is not sufficient for an oath /declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure. " Rather, the oath /declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See ***In re Constant***, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.> A statement of " ... failure to include a claim directed to ..." and then presenting a newly added claim, would not be considered a sufficient " error" statement since applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa. Such a statement would be no better than saying in the reissue oath or declaration that " this application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10." In both cases, the error has not been identified.<

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Furthermore, in the remarks filed 2/19/2002 applicant states "claim 1 has been amended whereby to delete a **superfluous limitation** which appeared at the end of claim 1 which defines the control circuit means as having **power sensing means** and also as having means to control the operation of the device", while **new claim 17** adds the very same superfluous limitation "**power sensing means**".

3. In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Thus, an error under 35 U.S.C. 251 has not been presented where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a 35 U.S.C. 251 error is already present).

4. Newly amended/added claims 1, 2, 17, 18 were not presented in an acceptable form: an amendment of a "new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. See MPEP § 1453.

5. Claims 2, 18 are rejected under 35 U.S.C. 251 as being **improperly broadened in a reissue application** made and sworn to by the assignee and the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. Claims 10-15 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material, which is not supported by the prior patent, is as follows: "**power sensing means to monitor...integration fuel cell and battery DC supply**".

***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the conventional names, as described in the specification, e.g. fuel cell, etc. for the elements shown in figures with non-conventional symbols. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the auxiliary electrical outlet connector must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the

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filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

8. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

9. The amendment filed 2/19/2002 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: "power sensing means to monitor...integration fuel cell and battery DC supply". Applicant is required to cancel the new matter in the reply to this Office Action. Correction is required.

### ***Claim Objections***

10. Claims 1, 17, 18 are objected to because of the following informalities: "a.c." to be replaced by -AC- and "d.c" to be replaced by ---DC---.

Claim 1: "said stand-by energy supply" to be replaced by ---said fuel cell stand-by energy supply-- in order to provide proper antecedence.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1, 2, 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kohlstruck et al.** [6011324] in view of **Endo** [4,056,764 ].

The use of "or" throughout the claims make the claim language confusing because it is not clear what applicant is actually claiming. Furthermore, applicant is reminded that "**or**" should only be used with alternate terms, e.g., rod or bars, etc.

Applicant used repeatedly functional recitations in the claims, e.g., "for supplying", "for detecting", "for monitoring", "for connecting", which broaden the scope of the claims. Therefore, at the outset, the examiner notes that claims are to be given their broadest reasonable interpretation during prosecution. *In re Zletz*, 893 F 2d 319, 321, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989); *In re Pratner*, 415 F 2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969); *In re Yamamoto*, 740 F 2d 1569, 222 USPQ 934 (Fed. Cir. 1984); *Burlington Indus. V. Quigg*, 822 F 2d 1581, 3 USPQ 1436 (Fed. Cir. 1987); *In re Morris*, 43 USPQ 2d 1753, 1756 (Fed. Cir. 1997). In responding to this Office action, applicants are reminded of the requirements of 37 CFR 1.111 and 1.119 that applicants specifically point out the specific distinctions believed to render the claims patentable over the references in presenting responsive arguments. See MPEP 714.02. The support of any amendments made should also be specifically pointed out. See MPEP 2163.06. During patent examination, the pending claims must be "given their broadest reasonable interpretation **consistent** with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

Kohlstruck discloses in fig.1 a fuel cell 8 stand-by energy supply system for supplying electrical power to a device 1 operated by power from an electrical utility 6 in the event of a power failure, said fuel cell stand-by energy supply system comprising detection means for detecting a power failure/discriminators [see column 3, lines 51-54], control circuit means 12 for monitoring said detection means and one or more conditions of said device [see column 4, lines 42-45], said control circuit means 12 operating a fuel cell switch to connect a fuel cell or an integration fuel cell and battery DC supply directly or to a voltage conditioning circuit to produce an operative AC supply and for connecting said AC supply to said device to continue operation thereof during said power failure, said control circuit means

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having power sensing means and means to control the operation of said device so as to maximize the use of the power available in said fuel cell.

Endo discloses that a battery can be regarded as a power supply analogous to a capacitor. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Kohlstruck's apparatus and include a battery as a power supply, as disclosed by Endo, since the prior art element is an equivalent and performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).

As to claim 17, see remarks and reference above.

As to claim 18, Kohlstruck discloses the capacitor 19 supplies the consumers with energy during the short period of time between the drop in voltage and the full operation of the fuel cell, or respectively the opening of the switch 4 [see column 4, lines 7-10]. Therefore, it is an inherent function of the fuel cell stand-by energy supply system, disclosed by Kohlstruck, to maximize the use of the power available in said fuel cell or said integration fuel cell and battery DC supply, and MPEP 2100 states that the disclosure of a limitation may be expressed, implicit or **inherent**.

As to claim 2, the use of a microcontroller, absent any criticality, is only considered to be the use of "optimum" or "preferred" material that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide for the control device 12, disclosed by Kohlstruck, in order to optimize the time of response to power network fluctuations since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention. See *In re Leshin*, 125 USPQ 416. *In re Aller*, 105 USPQ 233 (CCPA 1955), *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

As to claims 10-16, see remarks and reference above.



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13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kohlstruck** and **Endo**, as described above, in view of disclosed prior art, **Ballard et al.** [4946096].

Kohlstruck does not disclose said device is an electrically operated fossil fuel forced air furnace or hot water heater, said device having a heat producing element and an electrically operated multi-speed blower motor, burner and controls.

Ballard discloses a furnace, which normally operates from a residential AC power source is adapted to operate on auxiliary DC power by changing the normal control function to substantially prevent the furnace from operating in the high heat mode during periods of auxiliary power use. Relays can be used to automatically connect the emergency power and to effect the change of the control function [see abstract]. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Kohlstruck's apparatus and include a furnace, as disclosed by Ballard, since it has been held that a recitation with respect to the manner or method in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See *Ex parte Wikdahl*, 10 USPQ2d 1546, 1548 (Bd. Pat. App. & Inter. 1989); *Ex parte Masham*, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Inter. 1987); *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967); see also M.P.E.P. § 2111.02. A process or environment of use limitation in an apparatus claim will not patentably distinguish the claim from the prior art unless it somehow imposes a structural limitation.

"[I]ntended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." M.P.E.P. § 2111.02 (citing *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)).

Official Notice is taken with regard to the device having a heat producing element and an electrically operated multi-speed blower motor, burner and controls since it is well known in the art to use an electrically operated multi-speed blower motor, burner and controls in order to operate a furnace.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kohlstruck** and **Endo**, as described above, in view of **Stich et al.** [5790391] in view of **Ouverwerk** [5498950].

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Kohlstruck does not disclose wherein there is further provided a charger connected to said power supplied by said electrical utility, said charger charging a battery supply for operating said microcontroller and its associated circuitry and switching devices.

Stich discloses a standby power system including a charger 36 connected to said power supplied by said electrical utility for operating said microcontroller 38 and its associated circuitry and switching devices to ensure that the battery 30 is fully charged, but is not overcharged, during the period when main AC power is available [see column 9, lines 45-47]. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Kohlstruck's and Endo's apparatus and include a charger, as disclosed by Stich, in order to ensure that the battery is fully charged, but is not overcharged, during the period when main AC power is available.

Kohlstruck and Stich do not disclose a battery supply.

Ouverwerk discloses a battery 35 coupled to a charger 11 for providing an unregulated power source. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Kohlstruck's, Endo's and Stich's apparatus and include a battery supply, as disclosed by Ouverwerk, in order to provide a continuous unregulated power source.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Allowable Subject Matter***

16. Claims 4-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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With respect to claims 4-8: none of the references of record prior to applicant's filing date discloses, teaches, or suggests a fuel cell stand-by energy supply system for supplying electrical power to a device operated by power from an electrical utility in the event of a power failure, said fuel cell stand-by energy supply system comprising, *inter alia*, wherein said heat producing element is supplied electric power through a first switch means, said electrically operated multi-speed blower having a speed control switch through which the speed of said motor is controlled.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related apparatus.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pia Tibbits whose telephone number is 571-272-2086. If unavailable, contact the Supervisory Patent Examiner Karl Easthom whose telephone number is 571-272-1989. The Technology Center Fax number is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PFT

March 26, 2006

Pia Tibbits

Primary Patent Examiner

